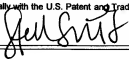


CERTIFICATE OF ELECTRONIC FILING		
I hereby certify that this correspondence is being filed electronically with the U.S. Patent and Trademark Office on the below date:		
Date: August 13, 2007	Name: Stephen C. Smith	Signature: 

BRINKS
HOFFER
GILSON
& LIONE

Our Case No. 10710-623  
(PTG 0633 PUS2)

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Dils et al.	)	
	)	Examiner: Nguyen
Serial No. 10/731,612	)	
	)	Group Art Unit No. 3724
Filing Date: December 9, 2003	)	
	)	Confirmation No. 4771
For: ERGONOMIC MITER SAW HANDLE	)	

## REPLY BRIEF

Mail Stop Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sirs:

In response to the Examiner's Answer mailed on June 15, 2007, Appellants have filed this Reply Brief. Appellants previously filed an Appeal Brief on May 9, 2007, and subsequently filed a Corrected Appeal Brief of July 27, 2007 to correct a typographical error in section VIII (Claims Appendix). This Reply Brief is timely filed within two months from the mailing date of the Examiner's Answer.

The arguments herein are intended to supplement the arguments presented in the Appeal Brief filed on May 9, 2007 (and Corrected Appeal Brief filed on July 27, 2007) in response to the arguments presented in the Examiner's Answer mailed on June 15, 2007.

**I. Claims 1-4 are Improperly Rejected Based on Bean, Svetlik, and Bidanset**

In the Examiner's Answer, the Examiner stated that the analysis of the dimensions of the components of Bean's handle and the derivation of those dimensions based on a comparison of Bean's design patent drawings to an alleged commercial embodiment miter saw were superfluous and unnecessary to meet the limitations of claims 1 and 4. In making this assertion, the Examiner stated that Bean anticipates claims 1 and 4 because Bean "teaches a miter saw comprising a base, an arm assembly having a handle [sic]. The handle comprises a gripping portion and a palm pad portion. See Figs. 1-7." Examiner's Answer, page 3. This analysis of the teachings of the Bean design patent vis-à-vis claims 1 and 4 is improper for at least the reason that the Examiner has not established that Bean discloses each of the limitations of claims 1 and 4. Bean's design patent drawings do not, in fact, disclose all of the these limitations.

While the Examiner is correct that claims 1 and 4 do not claim specific dimensions of a miter saw handle, the claims include structural limitations of the components of the handle that are not found or suggested in Bean. The Examiner's abridged summary of the limitations allegedly disclosed in Bean does not address all of the structural limitations of claims 1 and 4. For example, Bean does not disclose a handle that has a palm pad portion extending outwardly from the grip portion (of the handle) for a distance sufficient to underlie the heel portion of the palm of the user's hand, as in claim 1. Bean, at most, discloses a handle with a trigger that extends rearwardly therefrom. Thus, the user's fingers and hand would likely be placed on the handle to operate the trigger. Logically, the opposite side of Bean's handle would be the structure upon which at least a portion of the user's hand would rest. The structure of Bean's handle behind the trigger was identified as the "Palm pad portion" on the annotated figure provided on pages 4 and 10 of the Examiner's Answer mailed

on June 15, 2007 and the structure that receives the trigger was identified as the "Gripping portion" on the same figures.

The structure labeled "Palm pad portion" does not extend outwardly from the grip portion, as claimed in claim 1 and as defined in the specification. The specification refers to Figure 3 when stating that the "palm pad portion 44 extends outwardly toward the user in a sufficient distance to underlie the heel portion of the user's palm ... ." Specification, page 5, ll. 15-16. Figure 3 is a cross-sectional view of the miter saw handle and is a section of the view of the handle shown in figure 2. As shown in figure 2, the palm pad portion (44) extends outwardly from the grip portion (42) toward the user and away from the remainder of the handle. FIGs. 2 and 3 show a user's hand positioned on the handle with the palm pad portion (44) underlying the user's palm. The relevant dictionary definition for the adverb "outwardly" is "toward the outside." A copy of this definition is attached to Tab A of this Reply Brief. This definition is consistent with the specification and the drawings of the palm pad portion (44) and the grip portion (42) in figures 2 and 3.

In contrast to the statement by the Examiner in section 10 of the Examiner's Answer, Bean's alleged "Palm pad portion" (as identified by the Examiner) does not extend outwardly from the grip portion, or toward the outside of the grip portion of Bean's handle. While Bean's alleged "Palm pad portion" appears to be formed from the same member as Bean's "Gripping portion," Bean's alleged "Palm pad portion" does not extend outwardly, or toward the outside from Bean's alleged "Gripping portion." In contrast the "Palm pad portion" merely is the forward portion of the same member that includes the "Gripping portion" and is oriented in substantially the same manner as the remainder of the handle. Bean's "Palm pad portion" does not extend outwardly from Bean's "Gripping portion," or toward the outside of Bean's handle." For at least this reason, Bean cannot anticipate claims 1 and 4.

Further, the Bean design patent provides no scale or indication of the relative sizes of each component shown in Bean's figures. While Bean depicts a miter saw, there is no reference within Bean's disclosure or drawings to discern the size of each portion of Bean's handle. Therefore, Bean cannot anticipate the claim limitation of claim 1 that "the palm pad portion extend[s] outwardly from the grip portion for a distance sufficient to underlie the heel portion of the palm of the user's hand so that

... the palm pad portion transmits downward force from the user's hand to the handle thereby minimizing torque on the user's wrist." Because Bean does not disclose the size of the "Gripping portion" or the "Palm pad portion," Bean does not reasonably disclose that the "Palm pad portion" extends a distance sufficient to underlie the heel portion of the palm of the user's hand, as claimed. As discussed in the Appeal Brief filed on May 9, 2007 (and Corrected Appeal Brief filed on July 27, 2007), any attempt to discern the sizes of the components disclosed in Bean's design patent figures, or any comparison of Bean's figures with an allegedly similar (but not specifically identified) commercial embodiment of Bean's disclosure is improper. For this additional reason, the rejection of claims 1 and 4 as anticipated by Bean is improper. Moreover, because the secondary references combined with Bean to reject claims 2 and 3 (i.e. Svetlik and Bidanset, respectively) do not include the structure of claim 1 missing from Bean, the rejections of claims 2 and 3 are also improper.

**II. Rejection of Claims 1 and 4-9 over Brunson, Bean, and Pause is Improper**

In the Examiner's Answer, the Examiner states that the "motivation for a 35 USC 103 rejection is from a secondary reference or the level of knowledge of those of skill in the art but not from a primary reference." Regardless of whether this statement is legally correct, there is no reason to combine Brunson, Bean, and Pause without improper resort to hindsight. Pause discloses a rotatable handle for a hand saw and would not rationally be combined with either Brunson or Bean because the miter saws of these patents are dramatically different designs, and operate significantly different from Pause's hand saw. As discussed above, Bean's specification is simply figures 1-7, which do not provide any reason to modify Brunson's miter saw design with Bean's design. As a design patent, Bean necessarily provides no discussion of the basis for or benefits of Bean's design, and therefore one of ordinary skill in the art would have not reason to modify Brunson accordingly.

In the event that the Examiner's statement of law about the requirements to provide a motivation to modify a combination of references under 35 U.S.C. § 103 recited above is incorrect, and a reason to combine can properly be found in a

primary reference, Brunson provides no reason to modify its design to include the structure disclosed in either Bean or Pause. Brunson simply discloses that its miter saw includes a handle (24) and provides no further discussion of the handle's structure that is germane to the limitations of claims 1 and 4-9. Accordingly, one of ordinary skill in the art would not have had a reason to combine the structure of Bean and/or Pause to Brunson's handle. For this reason, the rejection of claims 1 and 4-9 is improper and the final rejection should be reversed.

Further, none of Brunson, Bean, or Pause, either alone or in combination, disclose all of the limitations of claim 1, let alone the claims dependent therefrom. Similar to the deficiencies of Bean discussed above, Brunson does not disclose a handle with a palm pad portion extending outwardly from the grip portion of a handle to underlie the heel of a user's palm. As shown in FIGs. 1-4, Brunson's miter saw (10) includes a handle (24), but the handle does not include any structure that could rationally be considered a palm pad portion extending outwardly from the grip portion a distance sufficient to underlie the heel portion of the palm of the user's hand. Moreover, Brunson's handle does not include any structure that extends outwardly as defined in the underlying specification. Pause is directed to a handsaw with a rotatable handle, and does not disclose any structure that is similar to the structure of claim 1. Because the Examiner has not established a *prima facie* case of obviousness of claims 1 and 4-9 based on Brunson, Bean, and Pause, Applicants respectfully request that the final rejection of these claims be reversed.

Appellants submit that the claimed invention is patentable in view of the cited references of record. Appellants therefore request reversal of the rejections of Claims 1-9.

Respectfully submitted,



Stephen C. Smith  
Reg. No. 56,250  
Attorney for Appellants

BRINKS HOFER GILSON & LIONE

Appl. No. 10/731,612  
Reply Brief in Response to Examiner's Answer Dated June 15, 2007

10710/623  
PTG 0633 PUS2

P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200

## TAB 1

# Merriam- Webster's Collegiate® Dictionary

ELEVENTH  
EDITION



Merriam-Webster, Incorporated  
Springfield, Massachusetts, U.S.A.





#### A GENUINE MERRIAM-WEBSTER

The name *Webster* alone is no guarantee of excellence. It is used by a number of publishers and may serve mainly to mislead an unwary buyer.

*Merriam-Webster*<sup>TM</sup> is the name you should look for when you consider the purchase of dictionaries or other fine reference books. It carries the reputation of a company that has been publishing since 1831 and is your assurance of quality and authority.

Copyright © 2005 by Merriam-Webster, Incorporated

#### Library of Congress Cataloging in Publication Data

Merriam-Webster's collegiate dictionary. — Eleventh ed.

p. cm.

Includes index.

ISBN-13: 978-0-87779-807-1

(Laminated unindexed : alk. paper)

ISBN-10: 0-87779-807-9

(Laminated unindexed : alk. paper)

ISBN-13: 978-0-87779-808-8

(Jacketed hardcover unindexed : alk. paper)

ISBN-10: 0-87779-808-7

(Jacketed hardcover unindexed : alk. paper)

ISBN-13: 978-0-87779-809-5

(Jacketed hardcover with CD-ROM : alk. paper)

ISBN-10: 0-87779-809-5

(Jacketed hardcover with CD-ROM : alk. paper)

ISBN-13: 978-0-87779-810-1

(Leatherlook with CD-ROM : alk. paper)

ISBN-10: 0-87779-810-9

(Leatherlook with CD-ROM : alk. paper)

ISBN-13: 978-0-87779-813-2

(Canadian)

ISBN-10: 0-87779-813-3

(Canadian)

ISBN-13: 978-0-87779-814-9

(International)

ISBN-10: 0-87779-814-1

(International)

I. English language—Dictionaries. I. Title: Collegiate dictionary. II. Merriam-Webster, Inc.

PE1628.M36 2003

423—dc21

2003003674

CIP

Merriam-Webster's Collegiate® Dictionary, Eleventh Edition, principal copyright 2003

COLLEGIATE is a registered trademark of Merriam-Webster, Incorporated

All rights reserved. No part of this book covered by the copyrights hereon may be reproduced or copied in any form or by any means—graphic, electronic, or mechanical, including photocopying, taping, or information storage and retrieval systems—without written permission of the publisher.

Made in the United States of America

5671T:QWV0504

